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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,516	05/31/2000	David A. Grabelsky	00,011	1984

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EXAMINER	
HOM, SHICK C	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/584,516	GRABELSKY ET AL.	
	Examiner	Art Unit	
	Shick C. Hom	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 34-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,34-37 and 39-41* is/are rejected.

7)☒ Claim(s) *38* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-13 and 34-41 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claims 3-4, 34-41 are objected to because of the following informalities: In claim 3 lines 2, 4, 6, 8 which recite the further steps of (a-d) should be renumbered to (e-h) because steps (a-d) have already been recited in claim 1. In claim 4 line 3, the word "a combination network address" seem to refer back to the "combination network address" recited in claim 1 line 12. If this is true, it is suggested changing "a combination network address" to ---the combination network address---. In claims 34-36 lines 8 and 13-14, the words "a second network address" seem to refer back to the "second network address" recited in claims 34-36 line 6, respectively. If this is true, it is suggested changing "a second network address" to ---the second network address---. Likewise, in claims 34-36 line 12 the words "a first network address" seem to refer back to the "first network address" recited in claims 34-

36 line 7, respectively. If this is true, it is suggested changing "a first network address" to ---the first network address---. Claims 34-36 line 13 the words "a second network subdevice" seem to refer back to the "second network subdevice" recited in claims 34-36 line 5, respectively. If this is true, it is suggested changing "a second network subdevice" to ---the second network subdevice---. Claims 34-36 lines 14-15 the words "a plurality of network devices on a second network" seem to refer back to the "plurality of network devices on a second network" recited in claims 34-36 line 9, respectively. If this is true, it is suggested changing "a plurality of network devices on a second network" to ---the plurality of network devices on the second network---. Claims 37-41 are objected to because they depend from objected claim 36. Appropriate correction is required.

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a

terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1, 3-7, 10-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent No. 6,996,621. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claim 1 merely broaden the scope of the U.S. Patent No. 6,996,621 claim 1 by using the term first and second network subdevices to refer to the remote access client and the realm specific Internet protocol enabled network device recited in the patent and eliminating the steps: (a) establishing a communication connection between a remote access client and a remote access server on a remote access network; (b) requesting by the remote access client from the remote access server a locally unique network address for communicating with network devices on the remote access network; (c) receiving by the dialup remote access client from the remote access server on the remote access network a locally unique network address for communicating with network devices on the remote access network; (d) receiving by the remote access client from the remote access server on the remote access network the locally unique network address of a network device on the remote access network,

wherein the network device is enabled for realm specific Internet protocol; and (f) if the remote access client is not enabled for realm specific Internet protocol, using network address translation with the locally unique network address of the remote access client to identify the remote access client for communications with the external computer network as in claim 1. U.S. Patent No. 6,996,621 step (e) including the steps (i)-(iv) is the same as the application's claim 1 except that the term "a globally unique network address" is recited in the patent and the term "a common external network address" is recited in the application; however they are merely referring to the network address. Likewise, the application's claim 3 merely broaden the scope of U.S. Patent No. 6,996,621 claims 1-2 by eliminating the elements recited above because claim 2 of the patent corresponds to claim 3 of the application and they dependent from claim 1 of U.S. Patent No. 6,996,621 and the present application, respectively. Likewise, the application's claims 4-7, 9-12 correspond to claims 3-4, 7, 9, 11-13 of U.S. Patent No. 6,996,621, respectively, and it merely broaden the scope of U.S. Patent No. 6,996,621 claims 1-3 and 1-4 for the same reasons given above. It has been held that the omission of a element and its function is an obvious expedient if the remaining elements perform the same function as before. In re

Karlson, 136 USPQ (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Lu et al. (6,009,474).

Regarding claims 34-36:

Lu et al. disclose a network access device, comprising in combination: (a) a first network; (b) a first network subdevice comprising a network client on the first (c) a second network subdevice on the first network comprising a network address server for allocating a second network address and one or more ports to the first network subdevice (see col. 1 lines 28-50 which recite the network including the client host, i.e. first

network subdevice, and server, i.e. second network subdevice, whereby re-allocation of the servers include re-assignment of the IP addresses of the servers to the client), wherein the second network subdevice has a first network address for communicating with other network subdevices on the first network and a second network address for communicating with a plurality of network devices on a second network, and wherein the network address server is used to allocate the second network address to the first network subdevice on the first network, wherein the first network subdevice has a first network address for communicating with other network subdevices and requests from a second network subdevice allocation of a second network address and one or more ports for communicating with a plurality of network devices on a second network; wherein the first network subdevice further comprises an IP interface and the client of the first network subdevice is a Realm Specific Internet Protocol host; the second network subdevice further comprises an IP interface and the network address server of the second network subdevice is a Realm Specific Internet Protocol gateway; and the first network subdevice further comprises a data application and a device control application (see col. 1 line 51 to col. 2 line 7 which recite the client transmitting a BOOTP request to the server, receiving the BOOTP response, and sending

a BOOTP reply to the server including the new network address for the assignment of IP addresses of the servers clearly reads on the first network address for communicating with other network subdevices on the first network, i.e. using the BOOTP protocol, and a second network address for communicating with a plurality of network devices on a second network, i.e. the IP addresses for communicating with the Internet).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that

was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 37 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu et al. (6,009,474) in view of Goss et al. (6,493,447).

Regarding claims 37 and 39-41:

Lu et al. disclose the network device described in paragraph 4 of this office action. Lu et al. disclose all the subject matter of the claimed invention with the exception of wherein the network access device is an Internet telephony gateway system as in claims 37 and 39-41.

Goss et al. from the same or similar fields of endeavor teach that it is known to provide wherein the network access device is an Internet telephony gateway system (in Fig. 10 see the devices, call center including the servers; customer device 42 having the telephone communicating on the first network and the PC communicating on the second network; and Internet telephony gateway ITG 192 on the PSTN).

Thus, it would have been obvious to the person having ordinary skill in the art at the time the invention was made to provide wherein the network access device is an Internet telephony gateway system as taught by Goss et al. in the network device of Lu et al. The network access device being an Internet telephony gateway system can be implemented by connecting the Internet telephony gateway system of Goss et al. to the network device of Lu et al. The motivation for connecting the Internet telephony gateway system as taught by Goss et al. to the network device of Lu et al. being that it provides a system and application in which the network device can function as designed.

Allowable Subject Matter

9. Claim 38 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
Perkins et al. disclose a shortcut network layer routing for mobile hosts.

Brewer et al. disclose a system with program for automating protocol assignments when newly connected to varying computer network configurations.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick C. Hom whose telephone number is 571-272-3173. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SH SH

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